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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,317	12/19/2000	Simon G. Thompson	36-1533	2567
23117	7590	07/13/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			NAHAR, QAMRUN	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/739,317

Applicant(s)

THOMPSON ET AL.

Examiner

Qamrun Nahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/589,200.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/05/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 4/5/05.
2. The objections to the drawings and specification are withdrawn in view of applicant's amendment and remarks/arguments.
3. Claims 1, 6, 7, 10 and 12-14 have been amended.
4. Claims 14-20 have been added.
5. Claims 1-20 are pending.
6. The objections to the specification are pending.
7. Claims 1-20 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Gryphon (U.S. 6,233,537).

### ***Priority***

8. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in European Patent Office on 11/08/99. The applicant has identified the parent application, S.N. 09/589,200, as containing the certified copy.

### ***Response to Amendment***

### ***Specification***

9. The disclosure is objected to because of the following informalities: "Summary of the Invention" section is missing.

Appropriate correction is required.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

10. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. The replacement paragraph beginning at page 1, line 11

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still contains browser-executable code “www.eil.utoronto.ca/iscm-descr.html”, which must be deleted. See MPEP § 608.01.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gryphon (U.S. 6,233,537).

**Per Claim 1 (Amended):**

The Gryphon patent discloses:

- **a method of generating a process plan** (“A modeling system for the visual presentation of event-driven business processes, composed of multiple plan elements, is provided.” in column 1, lines 50-65)

- **storing at least one generic process plan, storing at least one non-generic process element containing a predetermined pattern** (“Visual BML is modular. Each Visual BML diagram, referred to as a “plan,” describes the attributes and relationships of a single planned process.

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Each symbol can be deployed (reused) within the plans for other symbols as appropriate.” in column 2, lines 1-5)

- searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan, and outputting the generated process plan, wherein instructions for the insertion of said content in said step of inserting content are coded into said at least one non-generic process element (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57; “Action” is interpreted as a non-generic process element, where “Action” is associated with “Step”. A generic process plan is defined as a sequence of Steps, where each step is searched for an action that is associated with the step, and then an action is defined and deployed as part of the step; thereby, generating a new process plan. The instructions are coded into the Action.).

**Per Claim 2:**

The Gryphon patent discloses:

- the steps of receiving for storage at least one generic process plan and receiving for storage at least one non-generic process element (column 8, lines 16-25).

**Per Claim 3:**

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The Gryphon patent discloses:

- each stored generic process plan is indexed in accordance with a goal to be achieved by the plan, receiving a goal input, and selecting a generic process plan for searching, said selection being in accordance with the received goal input (column 6, lines 1-14).

**Per Claim 4:**

The Gryphon patent discloses:

- at least one non-generic process element comprises resource information, identifying one or more resources to support a process step in a generated process plan (column 6, lines 56-66).

**Per Claim 5:**

The Gryphon patent discloses:

- each stored non-generic process element comprising resource information is indexed in accordance with one or more relevant resources (column 6, lines 56-66).

**Per Claim 6 (Amended):**

The Gryphon patent discloses:

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- wherein content of at least one inserted process element comprises data (column 6, lines 56-66).

**Per Claim 7 (Amended):**

The Gryphon patent discloses:

- at least one non-generic process element comprises context specific method steps or data and is indexed for storage according to a relevant context (column 6, lines 56-66).

**Per Claim 8:**

The Gryphon patent discloses:

- the context for at least one non-generic process element is service type (column 6, lines 46-66).

**Per Claim 9:**

The Gryphon patent discloses:

- the context for at least one non-generic process element is customer type (column 6, lines 56-66).

**Per Claim 10 (Amended):**



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The Gryphon patent discloses:

- **selecting an item of content from two or more alternative items of content, said two or more alternative items of content being identified from said coded instructions provided by said at least one non-generic process element, and inserting the selected content into the generic process plan in generating a process plan** (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57).

**Per Claim 11:**

The Gryphon patent discloses:

- **wherein the selection is domain specific** (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57).

**Per Claim 12 (Amended):**

This is an apparatus version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also anticipated by Gryphon.

**Per Claims 13-14 (Amended):**

These are apparatus versions of the claimed method discussed above (claims 1, 10 and 11), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Gryphon.

**Per Claim 15 (New):**

The Gryphon patent discloses:

- wherein said content inserted from said at least one non-generic process element introduces a new process step into the generic process plan (column 7, lines 14-21).

**Per Claim 16 (New):**

The Gryphon patent discloses:

- wherein said content inserted from said at least one non-generic process element advises an existing step of the generic process plan (column 7, lines 24-31).

**Per Claims 17-18 (New):**

These are apparatus versions of the claimed method discussed above (claims 15-16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Gryphon.

**Per Claims 19-20 (New):**

These are apparatus versions of the claimed method discussed above (claims 15-16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Gryphon.

***Response to Arguments***

13. Applicant's arguments filed on 4/5/05 have been fully considered but they are not persuasive.

*In the remarks, the applicant argues that:*

a) Claims 1-14 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Gryphon et al (U.S. '537, hereinafter "Gryphon"). Applicant respectfully traverses this rejection.

For a reference to anticipate a claim, each element must be ... For example, Applicant submits that Gryphon fails to disclose searching a generic process plan for a predetermined pattern contained in a non-generic process element and inserting content from the non-generic process element into the generic process plan on detection of the predetermined pattern to generate a process plan, wherein the instructions for inserting content are coded into the non-generic process element as required by claims 1-14.

Gryphon teaches a modelling language ...

Gryphon fails to disclose or suggest searching a generic process plan for a predetermined pattern contained in a non-generic process element and inserting contents from the non-generic process element into the generic process plan on detection of the predetermined pattern to

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generate a process plan, let alone “wherein instructions for the insertion of said content in step of inserting content are coded into said at least one non-generic process element.”

The recitation of “wherein instructions for the insertion of said content in said step of inserting content are coded into said at least one non-generic process ... **weave instructions that are coded into the aspects 305 themselves** (emphasis added).”

Again, Gryphon fails to teach or suggest this limitation. In particular, nothing in Gryphon teaches the element primitives providing such coded instructions.

Accordingly, Applicant submits that claims 1-14 are not anticipated by Gryphon and respectfully requests that the rejection of these claims under 35 U.S.C. §102 be withdrawn.

*Examiner's response:*

a) Examiner strongly disagrees with applicant's assertion that Gryphon fails to disclose the claimed limitations recited in claims 1-14. Gryphon clearly shows each and every limitation in claims 1-14.

Gryphon teaches searching a generic process plan for a predetermined pattern contained in a non-generic process element and inserting content from the non-generic process element into the generic process plan on detection of the predetermined pattern to generate a process plan, wherein the instructions for inserting content are coded into the non-generic process element (column 6, lines 1-20; column 6, lines 47-67 to column 7, lines 1-57; “Action” is interpreted as a non-generic process element, where “Action” is associated with “Step”. A generic process plan is defined as a sequence of Steps, where each step is searched for an action that is associated

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with the step, and then an action is defined and deployed as part of the step; thereby, generating a new process plan. The instructions are coded into the Action.).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., weave instructions that are coded into the aspects) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, see the rejection above in paragraph 12 for rejection to claims 1-14.

*In the remarks, the applicant argues that:*

b) New claims 15-20 have been added to provide additional protection for the invention. Since these new claims depend at least indirectly from one of claims 1, 12 and 13, Applicant submits that these claims are allowable for at least the reasons discussed above.

Claims 15, 17 and 19 further require "wherein said content inserted from at least one non-generic process element introduces a new process step into the generic process plan." Claims 16, 18 and 20 further require "wherein said content inserted from said at least one non-generic process element advises an existing step of the generic process plan." In contrast, Gryphon teaches "All of the other connected primitives are aware simply of what is passed into or taken out of a neighbor primitive, not how that primitive accomplishes its task." (Col. 1, lines 2- 65).

*Examiner's response:*

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b) Examiner strongly disagrees with applicant's assertion that Gryphon fails to disclose the claimed limitations recited in new claims 15-20. Gryphon clearly shows each and every limitation in claims 15-20. Gryphon teaches wherein said content inserted from said at least one non-generic process element introduces a new process step into the generic process plan (column 7, lines 14-21); and wherein said content inserted from said at least one non-generic process element advises an existing step of the generic process plan (column 7, lines 24-31). In addition, see the rejection above in paragraph 12 for rejection to claims 15-20.

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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15. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN  
June 30, 2005

  
WEI Y. ZHEN  
PRIMARY EXAMINER